

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of STICE et al.

Appln. No. 09/394,902

Group Art Unit: 1636

Filed: September 13, 1999

Examiner: Unassigned

Title: CLONING PIGS USING DONOR CELLS OR NUCLEI FROM DIFFERENTIATED CELLS
(SOMATIC OR GERM CELLS) AND PRODUCTION OF PLURIPOTENT PORCINE
CELLS BY NUCLEAR TRANSFER

August 13, 2001

REQUEST FOR STATUS REPORT OF
U.S. PATENT APPLICATION

Honorable Asst. Commissioner of Patents
and Trademarks
Box DAC
Washington, D.C. 20231

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AUG 14 2001

OFFICE OF PETITIONS

Sir:

The last correspondence received from the U.S. Patent and Trademark Office in regard to the above-captioned patent application was the Notice of Recordation of Assignment Document received July 3, 2000.

The last correspondence filed with the U.S. Patent and Trademark Office was a Declaration of Facts Pursuant to 37 C.F.R. §1.47(a), a Petition for Extension of Time, a Petition Under 37 C.F.R. §1.47 and a Transmittal Letter for Missing Parts, all filed on April 6, 2000. Copies of these documents are enclosed for your convenience.

Please provide Applicants' undersigned representative with a status of this application.

Thank you for your attention to this request.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Robin L. Teskin

Reg. No. 35,030

Telephone No. 703.905.2200

Fax No. 703.905.2500

RLT:ml
1600 Tysons Boulevard
McLean, Virginia 22102
703.905.2000



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SEP 10 2001
TECH CENTER 1600/2900



Attorney's Docket No. 000270-026

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SEP 14 2001
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In re Patent Application of)

Steven L. STICE et al)

Application No.: 09/394,902)

Filed: September 13, 1999)

For: CLONING PIGS USING DONOR CELLS)
OR NUCLEI FROM DIFFERENTIATED)
CELLS (SOMATIC OR GERM CELLS)
AND PRODUCTION OF PLURIPOTENT)
PORCINE CELLS BY NUCLEAR)
TRANSFER)

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OFFICE OF PETITIONS

DECLARATION OF FACTS PURSUANT TO 37 C.F.R. §1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Robin L. Teskin, declare and state as follows:

(1) That I am a registered Patent Attorney who prepared and am responsible for the prosecution of the above-identified Patent Application.

(2) That I am responsible for prosecution of this application based on my representation of Advanced Cell Technology (ACT), the exclusive Licensee of the subject Application.

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CFL

(3) That promptly after preparation and filing of this Patent Application, I provided a complete copy of this Patent Application, including the Specification, Claims and Abstract, along with a Declaration and Assignment for execution by the inventors. In accordance with previous instructions and dealings with this client, ACT, I forwarded on September 14, 1999, and September 27, 1999, a complete copy of these documents to Michael D. West of Advanced Cell Technology, Inc. (ACT), the exclusive licensee of this application, and E. Bradley Moynahan of the University of Massachusetts, the Assignee of this application, who forwarded the documents to the inventors for the requisite signatures. A copy of these letters are attached as Exhibit 1 and 2.

(4) That sometime in late October of 1999, I received from Deborah Walsh (an employee in the office of Dr. Moynahan) the Declaration and Assignment documents which had been executed by all of the inventors except for Paul Golueke and Steven L. Stice. I was also advised by Ms. Walsh that Paul Golueke expressed an unwillingness to sign the Declaration and Assignment, apparently as a result of the termination of his employment with Advanced Cell Technology.

(5) After I did not receive the signed documents from Mr. Golueke, on January 17, 2000 I sent via courier a second complete copy of the as-filed Patent Application, and the Declaration and Assignment to Paul Golueke. I further sent a letter requesting that Mr. Golueke sign, date and return these documents to us by February 6, 2000, so that they could be filed in the U.S. Patent and Trademark Office. A copy of this letter is attached

as Exhibit 3 to this Declaration. As in several other applications prosecuted by us naming Dr. Golueke as an inventor, Paul Golueke did not execute any documents that are assigned to the University of Massachusetts and exclusively licensed to ACT. Mr. Golueke did not execute or return these documents by the appointed date of February 6, 2000.

(6) After I had not received the signed documents as of February 27, 2000, I thereupon attempted to contact Paul Golueke by telephone. I learned that his address had since changed to 620 Constitution Avenue, Deforest, Wisconsin 53532. I thereupon obtained his new telephone number, and left him a phone message requesting that he provide us the executed Declaration and Assignment documents with his signature in order to avoid incurring additional government extension fees. However, I was unsuccessful and still have not received the executed Declaration and Assignment.

(7) As I also did not receive the signed Assignment and Declaration from Dr. Stice, I called Dr. Stice in January to determine when we would receive these documents. Dr. Stice advised that he was unwilling to sign these documents because of an obligation due him from Advanced Cell Technology, the exclusive licensee of this application. However, he indicated that he anticipated that this issue would likely be resolved soon.

(8) When in mid-February of this year I still had not received these documents, I again contacted Dr. Stice by telephone to determine the status of these documents. I also advised him that I would need to prepare a §147(a) Petition if I did not receive the


executed documents. Dr. Stice advised me then that he hoped to resolve his difficulties with ACT soon, and requested that I send him another copy of the documents by courier. I did so on February 17, 2000. A copy of this letter is attached as Exhibit 4.

(9) On March 1, 2000, when I still had not received the executed documents, I contacted Dr. Stice by telephone. He indicated that I should submit a Petition because of his unwillingness to sign these documents as he advised that he had still not resolved his difficulties with ACT, the exclusive licensee of this application.

(10) Thus, based on the foregoing, I prepared a Petition requesting that this Application be accorded §1.47(a) status based on the refusal of Paul Golueke and Steven L. Stice to sign the inventorship Declaration, and Assignment.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: April 6, 2000



Robin L. Teskin